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10/083,485	02/27/2002	Gonzalez Parada Adrian		4792

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EXAMINER

NGUYEN, CHAU N

ART UNIT

PAPER NUMBER

2831

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)
	10/083,485	ADRIAN ET AL.
	Examiner	Art Unit
	Chau N Nguyen	2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 23 June 2003 .

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 12-17,19 and 20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 12-17,19 and 20 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____ .

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

DETAILED ACTION

Specification

1. On June 23rd 2003, applicant filed an amendment to substantially amend the specification on page 7, second paragraph and on page 8, the first paragraph. However, the applicant does not enclose a mark-up copy to show the change made to the specification. Applicant should include a mark-up copy in the next response.
2. The disclosure is objected to because of the following informalities: in the amendment filed on June 23rd 2003, the amendment to the specification, page 2, there several typo errors such as "lawyers" should be changed to --layers--, "perifpheral" should be changed to --peripheral--, "tot eh" should be changed to --to the--, "P_{maz1}" should be changed to -- P_{max1}--, "oftapes" should be changed to --of tapes--. " V_{max1}" should be changed to --a_{max1}--. Those are just a few examples, applicant needs to check the typo errors through out the amendment. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not provide support for the claimed subject matter of "the tubular core consisting of a first layer of copper tapes" as claimed in claim 15.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 12-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12, line 4, "said corrugated flexible central core" lacks antecedent basis.

Claim 12, the recitation of "wherein a pitch of all the layers varies from a maximum P_{max1} (1000 cm) and P_{max2} (1000 cm) in the intermediate layers and a P_{min1} (2 cm) and P_{min2} (2 cm) in the external layers, while a twist of the tapes in all of the layers varies from α_{max1} (45 degrees) to α_{min1} (0 degrees) and from α_{max2} (45

degrees) to $\alpha_{\min 2}$ (0 degrees)" is unclear and causes confusion. What is it mean by varying from 1000 cm and 1000 cm and from 2 cm and 2 cm? The claim recites "the intermediate layers" and "the external layers" but no "internal (or inner most) layers". It is unclear that "the intermediate layers" and "the external layers" are the layers of the first group or of the second group because both groups each have a plurality of superconducting tape layers. Moreover, the limitations in the parentheses are vague since it is unclear that the limitations are positively claimed.

Claim 12, line 20, "the internal part" lacks antecedent basis.

Claim 12, lines 21 and 21, "the layer" and "each cable layer" are unclear to which layer that has been earlier recited.

Claims 13-17, 19 and 20, line 1, change "conductor" to --superconducting--.

Claim 17, line 2, "said superconducting tapes" is unclear since there are tapes from first group and tapes from second group.

Claim 19, line 2, "superconducting tapes of said layers" is unclear since there are tapes from first group and tapes from second group, and layers of tapes are formed by first group and second group.

Claim 19, lines 2-3, "a ratio of the number of superconducting tapes of said layers placed in opposite direction to one another is between 1:1 and 1:2" is vague.

Claim 20, line 2, "the flexible conductor core" lacks antecedent basis.

The above are but a few specific examples of indefinite and functional or operational language used throughout this claim, and are only intended to illustrate the extensive revision required to overcome the rejection under 35USC 112, second paragraph. The above mentioned corrections therefore, are in no way a complete and thorough listing of every indefinite and functional or operational language used throughout this claim. Applicant is required to revise all of the claim completely, and not just correct the indefinite and functional or operational languages mentioned.

No rejection based on prior art is given at this point of prosecution. MPEP 2173.06 states:

*“...where there is a great deal of confusion and uncertainty as to the proper interpretation of the limitations of a claim, it would not be proper to reject such a claim on the basis of prior art. As stated in *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962), a rejection under 35 USC 103 should not be based on considerable speculation about the meaning of terms employed in a claim or assumptions that must be made as to the scope of the claims.”*

Given the great arrangement of confusion and uncertainty as to the proper interpretation of the limitations of claims, it would not be proper to reject claims 12-20 on the basis of prior art.

Response to Arguments

7. Applicant's arguments with respect to claims 12-17, 19 and 20 have been considered but are moot in view of the new ground(s) of rejection.

Summary

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau N Nguyen whose telephone number is 308-0693. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (703) 308 3682. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Chau N Nguyen
Primary Examiner
Art Unit 2831